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| 10/743,076  | 12/23/2003  | Shigemi Wakabayashi  | 247117US0                       | 8104                        |
| 22850   | 7590        | 03/23/2007           |                                 |                             |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | EXAMINER<br>SHOSHO, CALLIE E    |                             |
|   |             |                      | ART UNIT<br>1714                | PAPER NUMBER                |
|   |             |                      | NOTIFICATION DATE<br>03/23/2007 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/743,076

Applicant(s)

WAKABAYASHI, SHIGEMI

Examiner

Callie E. Shosho

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 06 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-3 and 15-17.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Callie E. Shosho  
Primary Examiner  
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**Attachment to Advisory Action**

1. Applicant's arguments filed 3/6/07 have been fully considered but they are not persuasive.

Applicant argues that Gore et al. (U.S. 2003/0055178) is not a relevant reference against the present claims in light of the comparative data set forth in the present specification.

The data compares ink within the scope of the present claims, i.e. comprising water-insoluble polymer having alkyl group of 22 carbon atoms (example 1 or 2), with ink outside the scope of the present claims, i.e. comprising water-insoluble polymer having alkyl group of 1, 2, or 12 carbon atoms (comparative examples 1-3 or comparative examples 4-6). It is shown that the inks of the present invention are superior in terms of printing reliability, ratio of retaining viscosity, and ratio of retaining average particle diameter.

However, it is the examiner's position that the data is not persuasive given that the data does not compare ink of the present invention with ink of the "closest" prior art, namely, Gore et al.

That is, the ink of Gore et al. is closer to the presently claimed ink than the inks of the comparative examples. Specifically, Gore et al. disclose polymer particles comprising water-insoluble polymer having alkyl group of 16-24 carbon atoms in its side chain which is closer to the presently claimed polymer, i.e. having alkyl group of 20-30 carbon atoms in its side chain, than the polymers of the comparative examples, having alkyl group of 1, 2, or 12 carbon atoms in its side chain.

Applicants argue that the comparative data is sufficient given that while Gore et al. disclose the use of polymer obtained from C<sub>1</sub>-C<sub>24</sub> alkyl (meth)acrylate which includes low cut

(C<sub>1-6</sub>), mid-cut (C<sub>7-15</sub>), and high cut (C<sub>16-24</sub>) alkyl (meth)acrylate, there is nothing in Gore et al. to have selected out high cut (C<sub>16-24</sub>) alkyl (meth)acrylate and that the disclosure of Gore et al. only suggests a generic use of C<sub>1-24</sub> alkyl (meth)acrylates.

However, while Gore et al. disclose that the useful alkyl (meth)acrylates are C<sub>1</sub>-C<sub>24</sub> alkyl (meth)acrylates, it is significant to note that Gore et al. explicitly disclose that in one embodiment, the alkyl (meth)acrylate contains 16-24 carbon atoms. It is the examiner's position that Gore et al. do more than generically disclose C<sub>1</sub>-C<sub>24</sub> alkyl (meth)acrylate by disclosing three different types of alkyl (meth)acrylates that explicitly include C<sub>16</sub>-C<sub>24</sub> alkyl (meth)acrylate. While applicants argue that there is no need to compare against subject matter which does not exist in the prior art, it is the examiner's position that the subject matter, i.e. polymer obtained from C<sub>16</sub>-C<sub>24</sub> alkyl (meth)acrylate, does exist in Gore et al. given Gore et al.'s disclosure of three types of alkyl (meth)acrylate which includes the explicitly recitation of C<sub>16</sub>-C<sub>24</sub> alkyl (meth)acrylate.

Further, while it is agreed that there are no examples in Gore et al. that utilize polymer obtained from C<sub>16</sub>-C<sub>24</sub> alkyl (meth)acrylate, "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others", *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). Further, "nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims", *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960).

It is further noted that the comparative data is not persuasive given that the data is not commensurate in scope with the scope of the present claims. Specifically, the present claims

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require the polymer have acid value of 30-120 mg KOH/g, however, there is no disclosure in the examples regarding the acid value and thus, it is not clear if the polymers possess acid value that falls within the scope of the present claims.

In light of the above, it is the examiner's position that the comparative data is not successful in establishing unexpected or surprising results over the "closest" prior art namely, Gore et al. and thus, Gore et al. remains a relevant reference against the present claims.



Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
3/20/07